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Examiner Michael Datskovskiy**From: RABIN & BERDO****Firm: USPTO****Fax: 703 872-9306****Pages: 4 INCLUDING COVER****Phone: 571 272-2040****Date: September 7, 2005****Serial No. 09/376,063****Our Ref.: OKI 226/PGA**

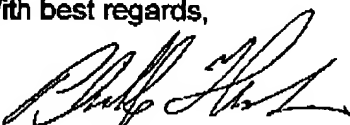
☐ Urgent ☐ For Review ☐ Please Comment ☐ Please Reply ☐ Please Recycle

• Comments:

Dear Examiner Datskovskiy,

I have attached a copy for your information of a paper submitted today in response to your Notification of Non-Compliant Appeal Brief. Your most expeditious consideration of this submission would be gratefully appreciated. Please feel free to call me if you would like to discuss.

With best regards,


Phillip Avruch
RABIN & BERDO, PC

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SEP 07 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCESGroup Art Unit: 2835
Examiner: M. Datskovskiy

In Re PATENT APPLICATION Of:

Applicant: Seiji ANDOH)

Serial No.: 09/376,063)

Filed: August 17, 1999)

For: PACKAGE STRUCTURE FOR A)
SEMICONDUCTOR DEVICE)

Attorney Ref: OKI 226)

RESPONSE TO
NOTIFICATION OF
NONCOMPLIANT
APPEAL BRIEF

September 7, 2005

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is timely submitted in response to the Notification of Non-Compliant Appeal Brief mailed August 29, 2005. The Office is respectfully requested, for the reasons set forth in the following Remarks, to reconsider and withdraw the requirement to correct the alleged defects in the Appeal Brief identified by the Examiner in said Notification.

REMARKS

The Notification of Non-Compliant Appeal Brief mailed August 29, 2005 ("Notification") indicates that the Appeal Brief filed August 9, 2005, does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order. Specifically, the Examiner asserts that:

- (1) the item "Grouping of the claims" is missing; and

- (2) the Item No. 6, "Grounds of rejection to be reviewed on Appeal" comprises rather a Status of the claims, and should be renamed as "Issues", and reformulated in accordance with 37 CFR 41.37.

The new Rules of Practice Before the Board of Patent Appeals and Interferences were published at 69 Fed. Reg. 49959 (August 12, 2004) and became effective on September 13, 2004. In its written Clarification of the Effective Date Provision of the new rules, issued September 10, 2005, the Office made clear that any appeal brief filed on or after September 13, 2004 must be in compliance with the requirements set forth in new §41.37(c).

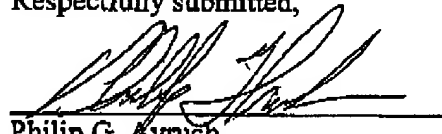
With regard to the first issue raised by the Examiner, the Federal Register notice of August 12, 2004 ("Federal Register") specifically states, "The grouping of claims requirements set forth in former rule 192(C)(7) is removed. The general purpose served by former rule 192(c)(7) is addressed in §41.37(c)(1)(viii)" (sic) (Federal Register at 49962). The rules commentary goes on to state, "In paragraph (c)(1)(vii), ... a separate heading is required for each ground of rejection in place of the previous grouping of claims section of the brief" (Federal Register at 49963). Thus, contrary to the Examiner's assertion, it is clear that the Appeal Brief in the present case is not required to have a "Grouping of the claims" section.

With regard to the second issue raised by the Examiner, new 37 CFR §41.37(c)(1)(vi) specifically requires that the appeal brief contain a section denominated "Grounds of rejection to be reviewed on appeal". The Examiner's insistence that this section should be renamed "Issues" is not understood. The rules commentary clearly states, "In paragraph (c)(1)(vi), a concise statement listing each ground of rejection presented for review is required rather than issues for review" (emphasis added) (Federal Register at 49962). Nor is it clear why the Examiner asserts "the Item No. 6, 'Grounds of rejection to be reviewed on Appeal' comprises rather a Status of the claims." The text of Section (vi) of the present Appeal Brief is fully compliant with the requirements of §41.37(c)(1)(vi) and consistent with the example given in the rules commentary (Federal Register at 49962). A "Status of Claims" section is a wholly different and separate requirement of the new rules, and is presented in Section (iii) of the Appeal Brief.

Thus, it is respectfully submitted that the Appeal Brief, as filed, complies with 37 CFR section 41.37(c), and that the requirements imposed by the Examiner in the Notification appear to be based on previous rules that are no longer applicable, and accordingly, should be withdrawn. The Examiner's most expeditious reply to this submission is kindly requested.

If the Examiner believes that a conference would help to expedite the resolution of the issues addressed herein, the Examiner is encouraged to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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